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In re Application of	:	DECISION ON
Baum et al	:	
Application No.: 09/831,621	:	
PCT No.: PCT/US99/26788	:	PETITION UNDER
Int. Filing Date: 10 November 1999	:	
Priority Date: 10 November 1998	:	37 CFR 1.137(b)
Attorney's Docket No.: 98.664-B	:	
For: Novel DNAs and Polypeptides	:	

This decision is in response to applicants' "Petition For Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137," filed on 24 January 2006. The petition fee has been paid by check.

BACKGROUND

On 10 November 1999, this international application was filed, claiming an earliest priority date of 10 November 1998.

A Demand electing the United States was filed in this international application on 06 June 2000. Accordingly, the deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.494 was 10 May 2002. This international application became abandoned with respect to the United States at midnight on 10 May 2002 for failure to pay the required basic national fee.

On 10 May 2001, applicants filed the instant petition under 37 CFR 1.137(b) and Transmittal letter for entry into the national stage in the United States, which was accompanied basic national fee. No executed declaration or oath was submitted at such time.

On 13 August 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a copy of the "Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application. A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date." The notification set two (2) months time limit or 32 months from the priority date for the application, whichever is later to respond, and that failure to respond would result in abandonment.

In addition, on 13 August 2001 a Notification to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (Form PCT/DO/EO/905) indicating that the application failed to comply with the requirements of 37 CFR 1.821-1.825.

On 15 November 2002, the USPTO mailed applicant Notification of Abandonment (Form PCT/DO/EO/909) indicating the application was abandoned because applicant failed to respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905), mailed 08/13/2001 within the time period set therein.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Petitioner has provided: (1) the proper reply by submitting the basic national filing fee, and (2) the petition fee set forth in § 1.17(m). In this application, no terminal disclaimer is required.

With respect to item (3), there appears to be a question whether the delay was unintentional and additional information will be necessary to explain the filing the petition. The record shows that the Notification of Abandonment was mailed 15 November 2002 and applicants did not submit a petition to revive until 24 January 2006 a delay of more 4 years without elaborating why the this extensive delay should be construed as unintentional. Accordingly, pursuant to 37 CFR 1.137(b)(3), applicants are required to provide an explanation why the entire delay in filing the petition should be construed as an unintentional delay.

Consequently, the petition is deemed to not to satisfy requirement (3) under 37 CFR 1.137(b).

In addition, the assignee, Neurome, Inc., has not complied with 37 CFR 3.73(b) in that the filed papers are not accompanied by documentary evidence of the chain of title from the assignor, Digital Gene Technologies, to the assignee for the invention of the aforementioned. To establish the right of the assignee to take action, applicant must submit a copy of the executed assignment or specify the reel and frame number. Note MPEP 324 and 37 CFR 3.73(b).

DECISION

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.137(b) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Failure to timely submit the proper reply will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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